

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number: 02103-581001/W35
	Application Number 10/752,391	Filed January 6, 2004
	First Named Inventor William Allen et al.	
	Art Unit 2612	Examiner Vernal U. Brown

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).  
 Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.  
 See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record 18,411  
 (Reg. No.)

☐ attorney or agent acting under 37 CFR 1.34.  
 Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

/charles hieken/

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Signature

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Charles Hieken

Typed or printed name

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(617) 542-5070

Telephone number

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February 10, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☒ Total of 1 form is submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	William Allen et al.	Art Unit :	2612
Serial No. :	10/752,391	Examiner :	Vernal U. Brown
Filed :	January 6, 2004	Conf. No. :	3571
Title :	REMOTE CONTROLLING		

**Mail Stop Appeal Brief - Patents**

Hon. Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF**

Claims 1-3, 7 and 8 stand rejected under U.S.C. § 103(a) as being unpatentable over Sciammarella as a primary reference in view of Ellis as a secondary reference.

This ground of rejection is respectfully traversed.

*In KSR Int'l Co. v. Teleflex Inc.*, 82 U.S.P.Q. 2d 1385, 1396 (U.S. 2007), after stating the steps “in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent in issue”, the Court said, “To facilitate review this analysis should be made explicit.” See *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) (“[R]ejections on obvious grounds cannot be sustained by mere conclusory statements, instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”).

“A fact finder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. See *Graham*, 383 U.S., at 36 (warning against a “temptation to read into the prior art the teachings of the invention in issue” and instructing courts to “guard against slipping into the use of hindsight” (quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F. 2d 406, 412 [141 USPQ 549] (CA6 1964))). *Id.* 1397.

In *Ex parte Aylward*, (BPA&I, Appeal No. 2007-2368 December 4, 2007) the Board said in reversing a final rejection,

"Both anticipation under §102 and obviousness under §103 are two-step inquiries. The first step in both analyses is a proper construction of the claims . . . . The second step in the analysis requires a comparison of the properly constructed claims to the prior art". Medichem, S.A. v. Rolabo, SL., 353 F. 3d 928, 933 (Fed. Cir. 2003) (internal citations omitted):

#### A. CLAIM CONSTRUCTION

"The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art." *In re Lowry* 32 F. 3d 1579, 1582 (Fed. Cir. 1994) (citing *In re Gulack*, 703 F. 2d. 1381, 1385 (Fed. Cir. 1983). Slip Op. Pp. 7-8.

\* \* \*

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing *in re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781,783 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F. 2d 1048, 1051 (CCPA 1976)).

*In Ex parte Hamilton* (BPA&I Appeal No. 2007-3091, March 11, 2008) in reversing a final rejection the Board said:

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See *In re Kahn*, 441 F.3d 977, 987-88 (Fed. Cir. 2006), *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991), and *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

The Examiner can satisfy this burden by showing some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Slip Op. Pp. 5-6.

The pertinence of the specification to claim construction is reinforced by the manner in which a patent is issued. The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Acad. Of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). *Phillips v. AWH Corp.*, 76 U.S.P.Q. 1321, 1329 (Fed. Cir. 2005) (en banc).

The claim language must be interpreted in light of the specification as it would be interpreted by one of ordinary skill in the art. The application is entitled REMOTE CONTROLLING. FIG. 2 of the application, reproduced on the cover page of the published application, shows remote controller 50 with display 52 that furnishes the indications to the user of the control device, remote control 50, and indication of the value representative of a current preset associated with a sound signal source, the current preset having been preselected by the user as being of interest and simultaneously providing an indication of a value of a possible new preset associated with the sound signal source and providing the user an edit option.

In explaining the display on display 52 shown in FIG. 4B, the specification explains the claimed limitations in ¶¶ 41-42 as, “While a station is highlighted, the user may enter (and may change) a new value 126 for the preset. Both the current preset 124 and the new value 126 are shown on display 52 at the same time. To enter a new value for the highlighted preset, the user presses the center button 58 up or down to tune up or down, or the user can press the back button 68 and the forward button 70 to seek back or forward respectively.

\* \* \*

Having the current preset value 124 and the new preset value 126 visible on display 52 at the same time makes it easier for the user to be certain that the change that will be effected is the one he wishes and allows him to retain the current setting easily if he chooses not to change it.”

Neither the primary reference nor the secondary reference discloses a remote control with a display. Nor does either reference disclose “simultaneously providing an indication of a value of a possible new preset associated with the sound signal source” while “providing to a user of a

control device, an indication of a value representative of a current preset associated with a sound signal source, the current preset having been preselected by the user as being of interest," as recited in all the rejected active claims.

It is therefore impossible to combine the primary and secondary references to meet the limitations of these rejected claims.

"Moreover, we observe that even if these references were combined in the manner proposed by the examiner, that which is set forth in appellant's claims . . . would not result." *Ex parte Bogar*, slip op. p.7 (BPA&I Appeal No. 87-2462, October 27, 1989). "Even if we were to agree with the examiner that it would have been obvious to combine the reference teachings in the manner proposed, the resulting package still would not comprise zipper closure material that terminates short of the end of the one edge of the product containing area, as now claimed." *Ex parte Schwarz*, slip op. p.5 (BPA&I Appeal No. 92-2629 October 28, 1992). "Although we find nothing before us indicating why it would be desired to combine the references in the manner urged by the examiner, it is clear to us that such a modification by itself would not result in that which is set forth in the claims." *Ex Parte Kusko*, 215 U.S.P.Q. 972, 974 (BPA&I 1981).

That it is impossible to combine the references to meet the limitations of the rejected claims is reason enough for withdrawing the rejection of them. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in the references regarded as corresponding to at least the limitations in at least claim 1.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the primary and secondary references and further in view of Obayashi as a tertiary reference.

This ground of rejection is respectfully traversed.

Claim 6 is dependent upon and includes all the limitations of claim 1. We have shown above that Claim 1 is patentable over the primary and secondary references so that it is submitted to be unnecessary to further discuss the additional limitations added by claim 6.

In view of the foregoing authorities, reasoning and the inability of the prior art, alone or in combination, to anticipate, suggest or make obvious the subject matter as a whole of the invention defined by the limited number of rejected claims, all the claims are submitted to be in a condition of allowance, and notice thereof is respectfully requested.

Respectfully submitted,  
FISH & RICHARDSON, P.C.

10 February 2010  
Date: \_\_\_\_\_

/charles hieken/  
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Charles Hieken  
Reg. No. 18,411  
Attorneys for Application Owner

Fish & Richardson P.C.  
225 Franklin Street  
Boston, MA 02110  
Telephone: (617) 542-5070  
Facsimile: (877) 769-7945